Decision for dispute CAC-UDRP-101427

Case number	CAC-UDRP-101427
Time of filing	2018-06-26 14:43:44
Domain names	brunellocucinelli.shop

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Brunello Cucinelli S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Name	Y. v. Oostendorp

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings pending or decided which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant, Brunello Cucinelli S.p.A., is the proprietor of inter alia the following earlier trademarks:

- BRUNELLO CUCINELLI (word), international registration No. 925651 of March 21, 2007, with an Italian priority date of March 15, 2007, claiming protection for goods in classes 3, 9, 18, 24 and 25, designating Japan, the European Union, Australia, South Korea and China,

- BRUNELLO CUCINELLI (word mark), international trademark registration No. 537288 of April 7, 1989 , covering goods in class 25, based upon an Italian registration dating back to May 23, 2006, and designating France, Russia, Spain, Germany, Ukraine, Switzerland, Austria, Benelux, and China;

- BRUNELLO CUCINELLI (word mark), EUTM registration No. 8458515, filed on July 29, 2009, and granted on January 12, 2010, covering services in class 35;

- BRUNELLO CUCINELLI (word mark), EUTM registration No. 11879855, filed on June 7, 2013, and granted on October 16, 2013, covering goods and services in classes 3, 9, 18, 20, 21, 24, 25, 26 and 41.

FACTUAL BACKGROUND

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The Complainant is the Italian company Brunello Cucinelli S.p.A., founded in 1978 by an Italian fashion designer and entrepreneur, named Brunello Cucinelli. From the outset, the Complainant manufactured and sold colored knitwear for women. The market showed a huge interest in these products and this allowed the Complainant to grow quickly. The Complainant subsequently expanded its activity to other types of clothing, including shoes, bags, accessories, throws, linens, etc., but is still driven by the desire to create a different way of doing business, based on a contemporary form of humanism that over the years the international press has identified as a “humanistic” capitalism, where profit can be sought without damaging mankind.

In 2012 the Complainant was listed in the Milan stock exchange, and its reputation is continuously and steadily growing, year by year. The presentation of the Complainant’s revenues for the year 2017 shows a consistent worldwide growth of the company’s turnover, crossing the 500 million Euro revenue threshold. The company’s activity is spread worldwide, with a more significant presence in Europe, North America and China. In 2017, the company's net revenues generated in Europe amounted to 235,6 million Euro, with a growth of a +10,6% over the year 2016. The Complainant's revenues generated in Europe in the year 2017 represent 46,8% of the company's total revenues, which amount to 503,6 Euro for the year 2017.

The Complainant’s retail network consists of 94 single brand boutiques worldwide in December 2017, with 4 new recent openings, and 30 wholesale single brand / multi-brand boutiques. The company also sells its products to end users in high profile shops, such as Harrod’s in London.

As far as Holland is concerned, which is where the Respondent is located, the Complainant operates through one single brand shop located in Amsterdam and several multi-brand shops.

Mr. Brunello Cucinelli and his company have been rewarded with several important national and international prices, among them the Global Ecomomy Price of the prestigious Kiel Institute for the World Economy. Mr. Brunello Cucinelli is invited as a speaker to several important international venues, where he is often called to illustrate his revolutionary method of entrepreneurship, for instance at the Dreamforce Conference held in San Francisco in November 2017.

In 2012, the Cucinelli family established a foundation, whose principal aim is to “embellish humanity”.

The Complainant is the owner of the well-known and distinctive trademark BRUNELLO CUCINELLI, registered internationally in many countries worldwide. The trademark BRUNELLO CUCINELLI is highly distinctive not only because it coincides with the name of the founder of the Complainant and has been also adopted as the Complainant’s name, but because the name “Brunello Cucinelli” is infrequent in Italy, and even more so abroad.

The Complainant is also the owner of numerous domain names containing the second level domain name <brunellocucinelli> registered both as gTLDs and as ccTLDs.

Considering the widespread and longstanding use of the BRUNELLO CUCINELLI trademark, as well as the substantial promotional investments made on this trademark and on the Complainant’s activity (in 2017 the company invested almost 29 million Euros in communication worldwide), the Complainant and its corresponding trademark are certainly to be considered well-known.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

LEGAL ARGUMENTS OF THE COMPLAINANT:

The Complainant argues that the disputed domain name is identical to the earlier Complainant's trademark BRUNELLO CUCINELLI, while the new gTLD ".shop", is a mere technical requirement, which does not affect the identity between the

signs and should be disregarded.

In any event, even if the Panel were to consider the new gTLD ".shop" in the assessment of the first requirement under Para. 4(a)(i) of the Policy, the Complainant maintains that the addition of this gTLD, will certainly make the two signs confusingly similar. As a matter of fact, the Complainant's activity is the manufacture and sale of its products, and the gTLD ".shop" is clearly suitable to persuade users that the disputed domain name is an e-commerce platform of the Complainant.

The Complainant contends that It is a generally established principle that the overall burden of proving the Respondent's lack of rights or legitimate interests in a disputed domain name lies on the Complainant. It is, however, sufficient to establish a prima facie case to reverse the burden of proof.

In the present case, the Respondent has not been authorised by the Complainant to reflect its well-known trademark in the disputed domain name. The Respondent is not a licensee, agent, distributor of the Complainant, nor has any business or any other kind of relationship with the Complainant. The Respondent is not the owner of a trademark application or registration, anywhere in the world, coinciding with the Complainant's BRUNELLOCUCINELLI trademark.

The Respondent does not appear to be known by the disputed domain name. Brunello Cucinelli is the full name of the founder of the Complainant; it is a unique name only belonging to him. A Google search conducted on "brunello cucinelli" only shows results referring to the Complainant. To the best of its knowledge, the Complainant is not aware of any other individual named "Brunello Cucinelli" either in Italy or abroad. A quick search made on the Italian white pages shows that all entries for "Brunello Cucinelli" refer to the Complainant.

The Respondent is not using the disputed domain name, or a name corresponding to the disputed domain name, in connection with a bona fide offering of goods or services. The disputed domain name does not lead to an active website and is passively used.

The passive holding of a domain name identical to a third party's renown trademark does not confer to the Respondent´s legitimate rights or interests under the Policy. The Respondent has registered and is passively holding a domain name corresponding to a third party's well-known trademark without authorization, as such preventing the legitimate owner of the BRUNELLO CUCINELLI trademark from reflecting its trademark under the gTLD ".shop".

Many UDRP Panelists have found that respondents who, without authorization, passively hold domain names corresponding to third parties' well-known trademarks, lack rights or legitimate interests in these domain names (see, among Others, Philip Morris USA Inc. v. Daniele Tornatore, Case No. D2016-1302, and Société nationale des télécommunications: Tunisie Telecom v. Ismael Leviste, WIPO Case No. D2009-1529 (noting that passive holding of a disputed domain name "does not constitute a legitimate use of such a domain name" that would give rise to a legitimate right or interest in the name).

Through a reverse domain name search conducted on the Respondent's name, it appears that the Respondent is the owner of numerous other well-known trademarks under the new gTLD ".shop". Among these, the Respondent is the owner of <fendicasa.shop>, <ralphlaurenhome.shop>, <robertocavallihome.shop>, <trussardicasa.shop> ecc., all registered between 26 and 27 September 2016, likewise the disputed domain name. It is an undisputable fact that the trademarks FENDI, RALPH LAUREN, ROBERTO CAVALLI and TRUSSARDI are well-known trademarks in the fashion field and that these trademarks do not belong to the Respondent.

Moreover, the Respondent was also the registrant of the domain name <loropiana.shop>, the ownership of which was duly transferred to Loro Piana S.p.A. following a UDRP decision dated 31 January 2018 (CAC Case No. 101335). In this decision the Panelist established that the three requirements under the Policy were duly satisfied. Thus, the Respondent was found to have registered a domain name identical to a third party's well-known trademark, lacking any right or legitimate interest in this domain name, and acting in bad faith. These are exactly the same circumstances of the current UDRP proceedings. For another recent case involving the Respondent, see WIPO UDRP Decision No. D2018-0400, Kravet, Inc v. Youri van Oostendorp, Calipseo B.V. / Y. v. Oostendorp, Calipseo B.V. involving the domain name <kravet.shop>. Also in this case, the

domain name at stake has been registered on September 26, 2016 and has not been used ever since. The complainant proved that the Respondent “registered some 292 domain names in addition to the disputed domain name. These other registrations include many incorporating well-known fashion or design brands such as <versacehome.shop>, <voguefashion.shop> and <jeanpaulgaultier.shop>, which do not resolve to an active website and apparently are not in use.”
As in the case involving the domain name <loropiana.shop>, the Respondent proffered speculative arguments in an attempt to convince the UDRP Panel that the domain name <kravet.shop> had been registered in preparation to a bona fide offering of goods and services (in particular for a platform to promote the sale of the Complainant’s products). In both cases the Panel rejected the Respondent’s arguments as unsubstantiated and groundless.
Accordingly, the Respondent has engaged in a “pattern of illegitimate conduct” by registering, without authorization, a high number of domain names identical to third parties' well-known trademarks (especially in the fashion field) under the gTLD ".shop", and by passively holding these domain names, pretending, without any supporting evidence, to own the relevant rights and legitimate interests.
In accordance with paragraph 4(a)(iii) of the Policy, in order to succeed in a UDRP proceeding, the Complainant must prove, as a third and last requirement, that the Respondent registered and used the disputed domain name in bad faith.

As far as registration in bad faith is concerned, the Respondent registered the disputed domain name containing a very well-known trademark belonging to a third party without authorization. Due to its reputation and its high distinctive character, the Respondent cannot have registered the disputed domain name by mere coincidence. Rather, the Respondent was well aware of the Complainant and of its well-known trademark at the time of the registration of the disputed domain name and deliberately decided to register a domain name identical to the Complainant’s trademark without worrying about the fact that he lacked any right to act as such. As mentioned above, the Complainant’s trademark coincides with the name and surname of the founder of the Complainant, and this name is unique. The Respondent has already engaged in a pattern of bad faith registration of third parties’ well-known trademarks, as it appears from the CAC and the WIPO UDRP decisions and from the results of the reverse Whois search.

As far as use in bad faith is concerned, previous UDRP Panelists have found that non-use of a domain name would not prevent a finding of bad faith. According to paragraph 3.3. of the WIPO Jurisprudential Overview 3.0., “[w]hile panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

In the instant case, the Complainant’s trademark is highly distinctive, and there is no plausible good faith use that the Respondent could make of the disputed domain name, considering the reputation of the BRUNELLO CUCINELLI trademark, and the lack of any authorization to use the Complainant’s trademark as part of a domain name.

For all the reasons mentioned above, the Complainant submits that the Respondent is using the disputed domain name to prevent the Complainant from reflecting its mark under the appealing new gTLD “.shop”. The Respondent has engaged in a pattern of such conduct, as it is confirmed by paragraph 3.1.2. of the WIPO Jurisprudential Overview 3.0., which states that “UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.”

In at least two prior occasions, other Panelists have found the Respondent to act in bad faith (CAC Case No. 101335 and WIPO UDRP Decision No. D2018-0400). Furthermore, the Respondent has abusively registered numerous other domain names coinciding with, or containing, well-known third parties’ trademarks.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to

a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "BRUNELLO CUCINELLI" as the difference between the disputed domain name and the Complainant's trademarks are insignificant to the overall impression.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

3. In the absence of a Response, the Panel infers that the Respondent had the Complainant's trademarks "BRUNELLO CUCINELLI" in mind when registering the Domain Name, which was therefore registered and is being (passively) used in bad faith, in order to take advantage of the reputation and the renown of the Complainant's trademarks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BRUNELLOCUCINELLI.SHOP**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2018-08-06

Publish the Decision